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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/440,243 11/15/99 LIEBENOW

F 450.264US1

EXAMINER

MM91/0612

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MINNEAPOLIS MN 55402

ART UNIT	PAPER NUMBER
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2854
DATE MAILED:

06/12/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 5-2-01

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are vague, indefinite and/or incomplete.

2/1/2 If the color designation is overridden (i.e. canceled) how can the next step of printing occur, absent or replacement with a different color designation?
a step of substitution

Claims are further vague as to whether or not the subset is printed as part of the printable information units when printing occurs.

Applicant's argument that the term "over ridden" is being interpreted too narrowly is not persuasive as all that is required is a reasonable interpretation with the specification as guidance.

Applicant's disclosure at page 2 states "the color designation is changed". This step is missing from *claim* ~~claim~~ 1 rendering the claim incomplete.
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Concerning the issue whether the subset is still being printed the examiner points out that claim 1 failed to clearly set forth that the subset is part of the information unit set being printed. Claim 1 should read "applying overruling sequence to" in line 2 to overcome this rejection.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al in view of Narendramath et al.

Rivette et al teaches creation of an "Equivalent File". This file is an electronically stored date file which can be created to have areas, such as Figure number, highlighted by user choice in

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a color different than the usual default color (black). The example is given of uses made of such a file by a patent attorney.

Claim 1 calls for the step of printing. Column 14, line 7 discloses use of printer 57. Column 16, line 3 refers to a "laser printer". Column 2, lines 60-62 indicate the text of a patent as originally published may be viewed. It would have been obvious to one of ordinary skill in the art, the patent attorney, identified as the user at column 2, line 59, that this patent may be printed in default black using printer 57.

The "subset" of applicants claim 1 would be for example, the Figure numbers found in the brief description of the drawings section of the patent.

Column 4, line 18, teaches the equivalent file may be annotated using "highlights". This indicates a change or substitution of display colors. This is the missing "override" step applicant could seemingly not find according to his remarks.

The "PTO Image File" referred to in columns 15 and 16 would be the original set and subset of information laser printer +printable in black. The "equivalent file" may be highlighted in portions as desired. This is the overriding step.

The secondary reference to Warendranath et al teaches use of a laser printer at column 3, lines 39 which can print in either black or multi-color. At the time of applicant's invention, it would have been obvious to one of ordinary skill in the printing arts, a complex art, to have used a multi-color laser printer for the printer 57 of Rivette et al. Motivation may be found in the

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ability of such a laser printer to print the "PTO Image File" in black and the changed i.e. highlighted) "Equivalent File" in multicolor.

Claim 2 calls for changing from a non-black color designation of a subset to a black color designation of a subset. This step is a color design choice. The third party receiving the ^{cut} ~~art~~ and ^{paste} ~~part~~ equivalent file may want to alter the color of the highlighted subsets. Claim 3 is taught by column 3, lines 46-50, of Rivette et al, which teaches "no human intervention to obtain a usable equivalent file".

Claims 4-11 and 15-30 are by default considered obvious over the above stated art rejection in view of counsels admission against interest that the species claims of the invention are so closely related they cannot be properly considered independent and distinct.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Eickholt/tr

6-5-01

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PRIMARY EXAMINER